Remarks

Claims 1-5 are pending in the application. New claims 6 and 7 have been added. In the Office Action dated July 19, 2002, the Examiner rejected claims 1-5 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner also rejected claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,105,011 to Morrison, Jr. (Morrison) in view of either U.S. Patent No. 6,269,348 to Pare, Jr. *et al.* (Pare) or U.S. Patent No. 5,262,941 to Saladin *et al.* (Saladin). The Examiner also objected to the drawings under 37 C.F.R. § 1.83(a).

Objection to Drawings Under 37 CFR 1.83(a)

The Examiner objected to the drawings stating that the drawings must show every feature of the invention specified in the claims. The Examiner appears to have two specific objections.

First, the Examiner states "claims 1 and 4 do not claim any storing feature." Apparently, the Examiner is referring to Figure 2, described as "a flow chart illustrating one method of determining collectability of a check writer provided by the present invention in accordance with the system of Figure 1." (Page 5.) Figure 2 includes block 112 bearing the text "STORING THE NEGATIVE INFORMATION IN THE DATABASE." The Examiner's logic appears to be twisted. The rule suggests that claimed elements should be illustrated, not that everything illustrated must be claimed.

Second, the Examiner states "claims 2 and 5 claim labeling features." Claim 2 is a method claim providing for labeling the check writer as collectable or non-collectable based on whether or not the pre-determined category within which the check writer is classified is within a preset category. Claim 5 is a system claim providing a mechanism for such labeling. The specification provides the following description (pages 7-8):

> Microprocessor 14 then removes the check writer information from negative file 18, if the predetermined category within which the check writer is classified is within the preset category. If the predetermined category within which the check writer is classified differs from the preset category, then microprocessor 14 retains the check writer information in negative file 18. Microprocessor 14 may retain the information by identification data, *e.g.*, name, social security number,

drivers license number or any other suitable data used to identify the check writer. For example, if the check writer information has a risk score that falls within 101-400, microprocessor 14 labels the check writer as a collectible customer, then the check writer information is removed from negative file 18. Negative file 18, having removed and retained information, may then be saved as scrubbed file 20. Being removed from negative file 18, the check writer information will not be found within a merchant accesses scrubbed file 20. Thus, the respective check writer will more than likely be approved by the merchant. Otherwise, the respective check writer information would have been accessed from scrubbed file 20 with the respective identification data, more than likely resulting in a denial to the check writer.

On the contrary, for example, if the check writer information has a risk score that falls between 0-100, microprocessor 14 labels the check writer as a non-collectible customer, then the information of the check writer is retained within scrubbed file 20. As a result, when a merchant accesses a scrubbed distributed negative file, the check writer information will be accessed, more than likely resulting in a denial to the check writer.

Microprocessor 14, negative file 18 and scrubbed file 20 are all illustrated in Figure 1. The drawings are clearly sufficient to facilitate an understanding of Applicants' invention. The Examiner is therefore respectfully requested to withdraw his objections.

Rejections Under 35 U.S.C. § 112

Claims 1-5 were rejected under § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention." In particular, the Examiner asserted that terms in claims 1 and 4 lacked an antecedent basis.

With regards to claim 1, the Examiner stated the following:

Claim 1, lines 4, 7, "the check writer" and "the information" each lack antecedent basis and each is not clear what is being referenced [sic].

Claim 1 is reproduced as follows, with emphasis added:

1.   A method of determining collectability of *a check writer* from a negative file including historical *negative information* of a plurality of check writers for check writing approval or denial, the method comprising:

> receiving *the* negative *information* of *the* check *writer* from the negative file;
>
> processing the negative information to determine a score of the check writer based on the information;
>
> classifying the check writer within a pre-determined category based on the score;
>
> removing the negative information of the check writer from the negative file, if the pre-determined category within which the check writer is classified is within a pre-set category; and
>
> retaining the negative information of the check writer in the negative file, if the pre-determined category within which the check writer is classified differs from the pre-set category.

The Examiner appears to be mistaken. There is no antecedent basis problem with regards to either "check writer" or "negative information" in claim 1.

With regards to claim 4, the Examiner stated the following:

> Claim 4, lines 4, 7, "the negative information" and "the information" each lack antecedent basis and is not clear what is being referenced [*sic*].

Claim 4 is reproduced as follows, with emphasis added:

> 4.   A system for determining collectability of a check writer from a database including historical *information* of the check writer for check cashing approval or denial, the system comprising:
>
> a first mechanism for receiving *the negative information* of the check writer from the database;
>
> a second mechanism for processing the negative information to determine a score of the check writer based on *the information*;
>
> a third mechanism for classifying the check writer within a pre-determined category based on the score;
>
> a fourth mechanism for removing the negative information of the check writer from the database, if the pre-determined category within which the check writer is classified is within a pre-set category; and
>
> a fifth mechanism for retaining the negative information of the check writer in the database, if the pre-determined category within which the check writer is classified differs from the pre-set category.

Arguably, there is no antecedent basis problem in claim 4, either. The Examiner should interpret the claim as written. Since there is only one "information" that can be an antecedent

basis, all "informations" that follow must use that "information" for an antecedent basis. Even though Applicants do not agree with the Examiner, claim 4 has been amended. This amendment is solely for the purpose of clarification, and does not in any way change the scope of claim 4.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-4 for obviousness under 35 U.S.C. § 103(a) as unpatentable over Morrison in view of either Pare or Saladin. Applicants respectfully disagree with these rejections.

Claim 1 provides a method of determining collectability of a check writer from a negative file including historical negative information of a plurality of check writers for check writing approval or denial. The negative check writer information is received from the negative file. The negative information is processed to determine a score of the check writer. The check writer is classified within a pre-determined category based on the score. Negative check writer information is removed from the negative file if the pre-determined category within which the check writer is classified is within a pre-set category. Negative check writer information is retained if the pre-determined category within which the check writer is classified differs from the pre-set category. Claims 2 and 3 depend from claim 1.

Claim 4, as amended, provides a system for determining collectability of a check writer from a database including historical information of the check writer for check cashing approval or denial. A first mechanism receives the negative information of the check writer from the database. A second mechanism processes the negative information to determine a score of the check writer based on the information. A third mechanism classifies the check writer within a pre-determined category based on the score. A fourth mechanism removes the negative information of the check writer from the database if the pre-determined category within which the check writer is classified is within a pre-set category. A fifth mechanism retains the negative information of the check writer in the database if the pre-determined category within which the check writer is classified differs from the pre-set category.

The Examiner's entire basis for rejecting claims 1-4 is to list each reference, indicate broadly what each reference teaches, and indicate in vague terms which of Applicants' elements might be disclosed. There is no citation of any kind and no specific mention of claim

elements. The Examiner has not even taken the trouble to address each claim individually.
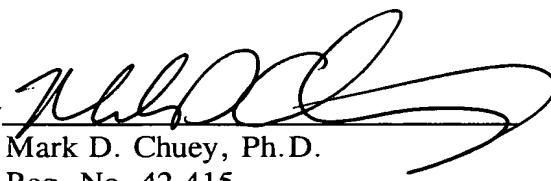
THIS IS TOTALLY UNACCEPTABLE!

The burden is on the Examiner to make a *prima facie* case. At the threshold, this requires showing how each and every element of each and every claim is disclosed by one of the references. And this requires, at the very least, *listing* each and every element. Then the Examiner must cite to some reference (column and line numbers or figure and reference numbers) which teaches this element.

With regards to the references listed by the Examiner, not one appears to teach or suggest negative check writer information that is removed from a negative file for any reason whatsoever. If the Examiner believes otherwise, the Examiner must provide a coherent argument supported by specific citations.

Applicants believe claims 1-7 meet all substantive requirements for patentability. Applicants therefore respectfully request allowance of this application. No fee is believed to be due by filing this paper. However, any such fee may be withdrawn from Deposit Account No. 02-3978 as specified in the Application Transmittal.

The Examiner is *sincerely invited* to contact the undersigned to discuss any aspect of this case.

Respectfully submitted for

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By _____

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Attachment

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1   4. (Amended) A system for determining collectability of a check

2   writer from a database including historical <u>negative</u> information of the check writer

3   for check cashing approval or denial, the system comprising:

4   a first mechanism for receiving the negative information of the check

5   writer from the database;

6   a second mechanism for processing the negative information to

7   determine a score of the check writer based on the <u>negative</u> information;

8   a third mechanism for classifying the check writer within a pre-

9   determined category based on the score;

10   a fourth mechanism for removing the negative information of the check

11   writer from the database, if the pre-determined category within which the check

12   writer is classified is within a pre-set category; and

13   a fifth mechanism for retaining the negative information of the check

14   writer in the database, if the pre-determined category within which the check writer

15   is classified differs from the pre-set category.